

REMARKS/ARGUMENTS

By this paper, Applicant replies to the Office Action of April 25, 2008 and respectfully requests reconsideration of the application.

Claims 28-46 are now pending, a total of 19 claims. Claims 28 and 40 are independent.

I. Paragraph 8 of the Action Confuses § 112 ¶ 1 with ¶ 2

Paragraph 8 of the September 2007 Office paper is unclear, because it does not arise under any statutory requirement. MPEP § 2173.04 confirms that teaching “how” is not a requirement for claims, only for the specification, and no question of “how to” can arise under § 112 ¶ 2. If a claim fails to state “how” something happens, that is simply irrelevant to § 112 ¶ 2. If it happens, no matter “how,” that language of the claim is satisfied, and if it doesn’t happen, that language of the claim is not satisfied. That yes or no question is all that matters for purposes of § 112 ¶ 2.

The term “automatically” is well understood in the art, to indicate “performed by a machine,” perhaps in response to a human initiation, perhaps in response to some other event, such as passage of a certain amount of time. Claims 31 and 36 state the triggering event for “automatically” performing a step. There would be no undue uncertainty in determining whether an embodiment did or did not fall within the scope of these claims.

II. Paragraph 11 of the Action Applies an Irrelevant Test for § 112 ¶ 1 Enablement

It is well established that a specification need not teach how to do something if that something is well-known in the art. The test for “enablement” is not whether “how to” is taught in the specification, the test is “undue experimentation.” The Office Action considers only irrelevant factors, and therefore fails to set forth any “enablement” rejection.

A. Legal Standard for Enablement

The test for “enablement” is “undue experimentation.” *In re Wands*, 858 F.3d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The enablement requirement may be met by the knowledge in the art, even if it is not in the specification or incorporated by reference. *Falkner v. Inglis*, 448 F.3d 1357, 1365, 79 USPQ2d 1001, 1006 (Fed. Cir. 2006). “A patent need not

teach, and preferably omits, what is well known in the art.” *Id.* “[A] patent applicant does not need to include in the specification that which is already known to and available to one of ordinary skill in the art.” *Koito Mfg. Co. v. Turn-Key Tech LLC*, 381 F.3d 1142, 1156, 72 USPQ2d 1190, 1200 (Fed. Cir. 2004). In the predictable arts, disclosure of a single operable embodiment generally suffices to enable broad claims. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1533 n. 5, 3 USPQ2d 1737, 1743 n. 5 (Fed. Cir. 1987) (“If an invention pertains to an art where the results are predictable, e.g. mechanical as opposed to chemical arts, a broad claim can be enabled by disclosure of a single embodiment.”); MPEP § 2164.03.

B. Procedural Requirements for Setting Forth an Enablement Issue

MPEP § 706.03(c), in note 3 to form paragraphs 7.31.02, requires that an “enablement” rejection discuss the *Wands* factors, and requires the Examiner to comply with MPEP §§ 2164.01(a) and 2164.04. MPEP § 2164.04 reads as follows, in pertinent part (citations and quotations omitted):

2164.04 Burden on the Examiner Under the Enablement Requirement

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. ... A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement requirement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support. ... As stated by the court, “it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.”

... the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments.

[T]he analysis and conclusion of a lack of enablement are based on the [*Wands*] factors discussed in MPEP § 2164.01(a) and the evidence as a whole... The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims.

C. The Office Action Fails to Set Forth any Enablement Issue

The Office Action merely asserts that certain information is not expressly in the specification. The Office Action's observations are irrelevant to enablement. *Falkner*, 448 F.3d at 1365, 79 USPQ2d at 1006.

Because the office Action sets forth no findings on "undue experimentation," the *Wands* factors, or "reasons for uncertainty of enablement," no rejection exists. Should a future Office Action come forward with these factors, Applicant will respond at that time.

III. The April 2008 Paper Misstates PTO Procedure

Paragraph 13 of the Action states an "Examiner Note." The "Note" is wrong. "Particular columns and line numbers in the references as applied to the claims" are not "for the convenience of the applicant." These, and more, are required by rule. 37 C.F.R. § 1.104(c)(2) sets the minimum standards for any validly-issued Office Action:

§ 1.104 Nature of examination.

(c) Rejection of claims.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

That is, in situations where the reference discloses anything more than or in addition to the invention claimed, as here, Rule 1.104 requires an Office Action must do two things:

(i) "designate" portions as nearly as practicable, and (ii) "clearly explain" the pertinence. It is the Examiner's burden to clearly explain all bases for any rejection. *Ex parte Berg*, 2002 WL 32346092 at *2, http://des.uspto.gov/Foia/RetrievePdf?system=BPAI&flNm=fd0_00456 at 4 (BPAI Feb. 6, 2003) ("the examiner must present a full and reasoned explanation of the rejection in the statement of the rejection, specifically identifying underlying facts and any supporting evidence, in order for appellants to have a meaningful opportunity to respond"). It is not an applicant's duty to guess at the Examiner's position. *Ex parte Schricker*, 56 USPQ2d 1723, 1725 (Bd. Pat. App. & Interf. 2000) (applicants are not required to "guess as to the basis of the rejection" or to "further guess... what part of [the references] supports the rejection").

The “Examiner Note” is not a PTO-approved form paragraph, and is contrary to written PTO guidance. Applicant requests that it not be used further – it merely creates confusion.

IV. § 102 and Kaminsky '967

Paragraph 14 of the Action discusses claim 28 in the context of Kaminsky '967. Claim 28 recites as follows:

28. A method comprising the steps of:

[i] at a computer system, receiving a first order from a first party, in which the first order indicates a first spread at which to make a market for a financial instrument and a second spread at which to make a market for the financial instrument, and in which the first order includes an acceptance by the first party to participate in the first market at the first spread and an acceptance by the first party to make a market at the second spread if the second party accepts the command;

[ii] from the computer system, transmitting information about the first order to the second party; and

[iii] at the computer system, receiving a second command from the second party, in which the second command comprises at least one of an acceptance of the first spread and an acceptance of the second spread;

[iv] if the second command comprises the acceptance of the first spread, requiring the first party to submit a third command indicating at least one of a buy and a sell of the financial instrument at a price reflecting the first spread, and

[v] if the second command comprises the acceptance of the second spread, requiring the second party to submit a third command indicating at least one of a buy and a sell of the financial instrument at a price reflecting the second spread.

The Office Action compares paragraphs [i] and [ii] to paragraph [0083] of Kaminsky '967.

Paragraph [0083] reads as follows:

[0083] The quote service module 240 receives quotes from market-makers as shown by line 272, and provides these quotes to the quote objects 250, 252, as shown by update lines 273, 274, and to the broker service module 230 as shown by line 276. As mentioned above, the quote service module 240 will not forward updated quotes (as opposed to new quotes) to the broker service module 230 before first canceling old quotes.

The correspondence between the following claim language and paragraph [0083] is not at all apparent.

- a “quote” or “command” or “order” that “indicates a first spread at which to make a market” – no “spread” is apparent in paragraph [0083]. Kaminsky’s quotes appear to be ordinary bids and offers at a single price.
- a “quote” or “command” or “order” that includes the obligations of the first party specified in paragraph [i] of claim 28 is not apparent in paragraph [0083].

Similarly, the limitations relating to the “first spread” and “second spread” recited in paragraphs [iv] and [v] of claim 28 are not at all apparent in the cited portions of Kaminsky, paragraphs 83-85 and Figs. 3 and 4.

Without some “designation as nearly as practicable” and “clear explanation of pertinence” as required by 37 C.F.R. § 1.104(c)(2), no rejection exists, and Applicant is neither required to or able to reply directly. Because the Action makes no showing that Jones ’123 corresponds to this language, the Action is insufficient to raise any rejection at all.

Applicant requests that claim 28 either be allowed, or examined in accordance with 37 C.F.R. § 1.104 and MPEP Chapter 2100.¹

V. Dependent claims

Dependent claims 29-39 are patentable with the independent claims discussed above. In addition, the dependent claims recite additional features that further distinguish the art.

VI. Conclusion

In view of the amendments and remarks, Applicant respectfully submits that the claims are in condition for allowance. Applicant requests that the application be passed to issue in due course. The Examiner is urged to telephone Applicant's undersigned counsel at the number noted below if it will advance the prosecution of this application, or with any suggestion to resolve any condition that would impede allowance. In the event that further extension of time is required, Applicant petitions for that extension of time required to make this reply timely.

¹ Because the claim amendments leave the scope of the claim largely unaffected, any discussion of these claim limitations in any future Action will likely not be “necessitated by amendment.” Any such new discussion will be a “new ground” that prevents final rejection.

Kindly charge any additional fee, or credit any surplus, to Deposit Account No. 50-3938, Order No. 01-1040.

Respectfully submitted,

Dated: October 27, 2008

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